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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,413	02/08/2002	David L. Heilman	N923	1691
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7590 06/15/2004

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11300 US Highway One
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EXAMINER

SNAY, JEFFREY R

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/071,413	Applicant(s) HEILMAN, DAVID L.	
	Examiner Jeffrey R. Snay	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, subparagraph iii is grammatically disconnected from the rest of the claim. Furthermore, the preamble introduces paragraphs i-iii by the phrase "comprising the steps of," whereas subparagraph iii fails to recite a step. Thus, the intended scope of the limitation presented in subparagraph iii is incomprehensible.

In claim 3, "tester" should be --testers-- and "are" should be --is--.

It is noted here that instant claims 4-7 are interpreted as NOT invoking 35 U.S.C. 112, 6th paragraph. Although the noted claims begin with "means for" language, the body of each of the claims recites sufficient specific structure to negate 6th paragraph application.

In claim 5, line 3, "said kit" lacks antecedent basis in the claim.

Claim Rejections - 35 USC § 102

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Haswell ('041).

Haswell discloses a method and kit which include all of the presently recited steps and structural elements, respectively.

With respect to the method of instant claim 1, Haswell teaches first the step of providing a kit. The kit includes, referring to Figures 1, 2, 3, 4 and 10 of Haswell, includes a container (50) for receiving a urine sample and a card (4) having printed indicia thereon.

The following applies to the particular form of the printed indicia presently recited in claim 1. It is noted that the claim has been considered as a whole, and the specific printed matter recited in the instant claims has been fully considered. However, the nature of the claimed printed matter is not functionally related to any structural element, nor to any method step. Rather, the claimed printed matter effects nothing more than to convey information to the human mind. As such, the actual content of the printed matter in the claim will not distinguish the invention from the prior art in terms of patentability. See, In re Gulack, 217 USPQ 401, 404 (Fed. Cir. 1983). For these reasons, the card (4) of Haswell, and printed indicia thereon, are considered to fully anticipate the presently recited membership card with indicia communicating directions for the cardholder, requests for the recipient government agent, and the name of a pre-ordained tester.

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With respect to the instant preambles recitation that the recited method is for "preserving the legal rights of an individual," it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Analogously, in a claim drawn to a process of using, the intended use must also result in a manipulative difference as compared to the prior art. In this case, the only manipulative steps of the recited method are those of providing a card with indicia and a kit which includes a container. These steps are fully disclosed in the single reference to Haswell.

Instant claim 2 adds a further limitation as to the content of the printed indicia on the card. However, for the reasons articulated above, the printed indicia of the instant claims is not functionally related to a structural element or manipulative process step. As such, the actual information conveyed by the printed indicia does not distinguish the invention over the prior art.

Instant claim 3 adds an additional step of "forming a unit of member testers [sic] that are available to a member of the unit." The meaning of this limitation is found in the specification, at pages 6-7, which clarifies that a unit is formed by association of the holder of the kit and another member who takes responsibility for performing the testing.

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Such a unit is established in the disclosure of Haswell because the kit includes a mailing envelope, which envelope is pre-addressed to an appropriate laboratory designated to conduct the future testing of the sample. See column 7, lines 1-2.

Instant claim 4 recites an article of manufacture comprising a card having indicia and a kit, which kit comprises at least one container for storing a urine sample. These elements are clearly present in Haswell as detailed above.

Instant claim 5 is fully disclosed by Haswell at Figure 10, depicting an outer container (58), an inner container (50) for holding a urine sample, and a pouch (92) for transporting the inner container (50). Claim 5 is alternatively anticipated by Haswell at Figure 1 depicting an outer container (90), inner container (50) and pouch (58).

With respect to instant claim 6, see Haswell at Figure 4 disclosing a cap for the urine sample receiving container. With respect to instant claim 7, see Haswell at column 5, lines 48-56, describing the presence of an adhesive label including identifying indicia.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Driver Rights Card (<http://web.archive.org/web/20001217103900/http://duiguy.com/myrights.htm>) in view of Haswell.

The Driver Rights card discloses a method and article for preserving an individuals legal rights. The method includes providing a membership card having printed thereon directions for the card holder to accept an agent's request for a sobriety test and for asserting a request to have a test done by an independent testing facility. The card also includes the printed name of an attorney. The instant method differs from the claimed invention in that it fails to include the additional step of providing a kit for collecting a urine sample for subsequent independent testing. Haswell discloses such a kit for the very purpose of collecting a urine sample for remote drug testing. It would have been obvious to one of ordinary skill in the art to augment the Driver Rights Card with the sample collection kit of Haswell in order to facilitate the desired additional and independent testing. Such combination of the Haswell kit with the Driver Rights Card would further have resulted in an article of manufacture which clearly included all the elements of instant claims 4-7. The manner of combination of the Card with the Haswell

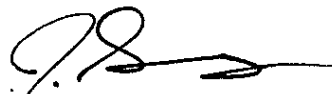
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kit would have been enabled to the skilled artisan at least by the disclosure of Haswell at column 5, lines 24-28, disclosing the kit as incorporating literature such as health information and instructions for use of the kit.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey R. Snay
Primary Examiner
Art Unit 1743

jrs

6-9-04